

## **REMARKS**

Claims 1-20 were presented for examination and were pending in this application. In the above-referenced Office Action, the Examiner rejected claims 1-10 under 35 U.S.C. § 112, second paragraph; rejected claims 1-10 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter; objected to the drawings; rejected claims 1-20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,173,316 to De Boor (hereinafter De Boor).

Applicant herein amends claims 1, 6, and 8 and adds new claim 21. These changes are believed not to introduce new matter, and their entry is respectfully requested. The claims have been amended to expedite the prosecution of the application in a manner consistent with the Patent Office Business Goals, 65 Fed. Reg. 54603 (Sept. 8, 2000). In making these amendments, Applicant has not and does not narrow the scope of the protection to which Applicant considers the claimed invention to be entitled and does not concede that the subject matter of such claims was in fact disclosed or taught by the cited prior art. Rather, Applicant reserves the right to pursue such protection at a later point in time and merely seeks to pursue protection for the subject matter presented in this submission.

Based on the above Amendment and the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections, and withdraw them.

## **Objection to the Drawings**

The Examiner has objected to Figure 6a, 6b, and 20 as being informal.

Approval of the Proposed Drawing Changes is respectfully requested. It is also respectfully requested that the Examiner explicitly indicate his approval thereof in the next official communication.

**Response to Rejection Under 35 USC § 112, Paragraph 2**

In the 3rd paragraph of the Office Action, the Examiner rejected claims 1-10 as allegedly not specifically pointing out and distinctly claiming the subject matter that Applicant regards as the invention. Claim 1 has been amended to obviate this rejection. Applicant note that claim 7 is an independent claim.

The Examiner states that claim 7 is dependent upon claim 1 (See Page 3, lines 16-17 of the Office Action). Because the Examiner has failed to discuss the alleged deficiencies of rejected independent claim 7, the rejection of independent claim 7 under § 112, Paragraph 2 is deficient and should either be clearly explained or withdrawn.

Applicant's amendment of the claims is made so as to more clearly define the invention, and not to narrow their scope of protection with respect to the prior art, or with respect to potentially infringing devices/compositions/articles.

**Response to Rejection Under 35 USC § 101**

In the 5th paragraph of the Office Action, the Examiner rejected claims 1-10 because the claimed invention is directed to non-statutory subject matter. Claims 1 and 6 have been amended to obviate this rejection.

The Examiner states that claim 7 is dependent upon claim 1 (See Page 3, lines 16-17 of the Office Action). Because the Examiner has failed to discuss the alleged deficiencies of rejected independent claim 7, the rejection of independent claim 7 under § 112, Paragraph 2 is deficient and should either be clearly explained or withdrawn.

Applicant's amendment of the claims is made so as to more clearly define the invention, and not to narrow their scope of protection with respect to the prior art, or with respect to potentially infringing devices/compositions/articles.

### **Response to Rejection Under 35 USC § 102(e)**

In the 8th paragraph of the Office Action, the Examiner rejects claims 1-20 under § 102(e) as allegedly being anticipated by DeBoor. This rejection is now traversed.

In a rejection under 35 U.S.C. §102(e), each and every claim element must be present in the applied reference.

Claim 1 recites a method for the direct execution of an XML-document in a data processing system, comprising:

defining the local behavior and process for each element of the XML-document;

integrating executable instructions with at least one XML-document or a document type definition (DTD); and

storing intermediate states of the execution process in an XML document in a memory of the data processing system by dynamically creating and redefining attributes of elements of the XML document.

Applicant believes that the invention of claim 1 has at least one aspect that is completely absent from DeBoor. Specifically, DeBoor completely fails to disclose or suggest a method including at least storing intermediate states of the execution process in an XML document of a memory of the data processing system by dynamically creating and redefining attributes of elements (emphasis added). Claim 1, for example, recites how the structure of the XML-document is directly reused as the structure of the computations, and thus in a natural way the intermediate state of such a computations are stored as attributes of elements (or possibly elements, see new claim 21) of the XML-document.

The Examiner contends that column 62, lines 9-10 of DeBoor discusses "(intermediate states of the process are stored and) replacing the tag with the second markup language page to form a combined markup language page (i.e. the elements are redefined)". DeBoor certainly contains the phrase "intermediate states," but the intermediate states discussed are merely states that are essential for programs and algorithms in general. It is commonly understood that a general computation/algorithm/program will have intermediate states. In DeBoor, a "next" method for forms allows for maintaining state of a multi-part form without having to repeatedly transmit hidden data between a client and server to

maintain the state. This is very different from the kind of intermediate state of computations recited in applicant's claims. In, DeBoor, the alleged "intermediate state" is just a way to enter a number of data fields in a number of screens, without having to communicate with the server, if switching from screen to screen. DeBoor does this if they want to display one form in several screens.

For example, the portion of DeBoor cited as showing storage of intermediate states of computations in XML-documents, making them executable (col. 62:9-10) describes the normal mechanism of a template language, which exists in one or the other form in most web-publishing systems, such as DTML in the Zope system, Java Server Pages, etc. All these known systems, and the system described by DeBoor, use XML and similar markup, including embedded PHP, Java, JavaScript or C code to render the content of a page, which is then displayed on various devices. It is important to understand that these technologies never store the intermediate state of the involved computations in the XML document, because the XML document is never considered to be related to the structure of the computation, but rather to the structure of the displayed content. Thus, claim 1 patentable distinguishes over the cited art for at least this reason.

The dependent claims of claim 1 are patentable for at least the same reason as claim 1.

Independent claim 7 discloses:

A system for use with the method according to one of the preceding claims, comprising: a server providing services to at least one client by executing at least parts of a XML-document according to a XML-robot specification sent from the client to the server or a server providing services to at least one client by sending a XML-robot specification and a XML-document to the client, such that said service is provided by executing of at least part of the sent document on the client according to the sent XML-robot specification.

DeBoor completely fails to disclose at least sending an XML document that is executed according to an XML robot specification. The portion of DeBoor cited by the Examiner relates to sending a form containing data to the server. The server then generates a page on the fly containing the data. Data in a form (as in DeBoor) is merely data and it not executable. For at least this reason, claim 7 and its dependent claims patentably distinguish over DeBoor.

The Examiner completely fails to address the following independent claims separately: claim 11-19. The sum total of the Examiner's rejection of these claims reads "As per claims 8-20, DeBoor also discloses such claimed limitations as addressed in claims 1, 3, 6, and 67 above. Applicant respectfully submits that this is not a sufficient explanation of the rejection to enable the applicant to respond."

Claim 8, for example, recites:

8. An apparatus for use with the method according to claim 1, comprising:

means for receiving from and sending data to a remote computer; means for storing and accessing a XML-document; means for integrating the XML-robot specifications with a XML-document and means for executing the integrated document.

The Examiner completely fails to discuss where DeBoor allegedly discloses a robot specification that is integrated with an XML document. If the Examiner persists in this rejections, he is respectfully requested to point out the section of DeBoor that the rejection is based on.

As another example, claim 11 recites:

11. An apparatus for the direct execution of XML documents, comprising:

means for graphical display of XML-robot specifications within an advanced visual integrated development environment; and

means for generating animations of the execution process.

The Examiner has completely failed to explain which section of DeBoor he is relying on for this rejection.

Similar concerns affect each of independent claims 12-19. If the Examiner persists in this rejection, he is respectfully requested to point to the sections of DeBoor on which he bases the rejection.

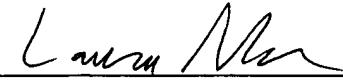
Based on the above Amendment and Remarks, Applicant respectfully submits that for at least these reasons claims 1-21 patentably distinguish over the cited references. Applicant respectfully submits that these are supported by the specification and are commensurate within the scope of protection to which Applicant believes they are entitled. Therefore, Applicant requests reconsideration of the basis for the rejections to these claims and request allowance of them.

In addition, Applicant respectfully invites the Examiner to contact Applicant's representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,  
PHILIPP W. KUTTER

Date: Mar 14, 2005

By:

  
Laura A. Majerus, Reg. No. 33,417  
FENWICK & WEST LLP  
801 California Street  
Mountain View, CA 94041  
Phone: (650) 335-7152  
Fax: (650) 938-5200

**IN THE DRAWINGS:**

The attached Letter to the Chief Draftsman submits replacement figures for Figs. 6a, 6b, and 20.